

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, a formal error in the specification has been corrected. Claim 1 has been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The examiner rejected Claims 1 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over Ehmig, U.S. Patent No. 6,257,476 (Ehmig), in view of Suckewer et al., U.S. Patent No. 6,321,733 (Suckewer).

Claims 2 and 3-4 were rejected under 35 U.S.C. §103(a) as being unpatentable as Claim 1 above and further in view of Mitchell U.S. Patent

No. 3,748,770 (Mitchell) and in view of Srinivasan et al., U.S. Patent No. 5,947,476 (Srinivasan) (claims 3-4).

Claims 5-6 were rejected as Claim 1 above and further in view of Giardini, U.S. Patent No. 4,203,393 (Giardini).

It is respectfully submitted that all of the claims 1-9 are patentable over the cited references. Specifically, Claim 1 recites that the annular electrode is displaceable together with the support between a first position, in which it is spaced from a cartridge cover foil, and a second position in which it contacts the cartridge cover foil.

The displaceable support and an annular electrode displaceable with the support is not disclosed in the prior art, including Ehmgig and Suckewer.

Ehmgig'476, as it is pointed out by the Examiner, discloses an ignition system for use in an explosion-operated power tool and having first and second electrodes 7 and 8 which are arranged in a support 6. As shown in Fig. 1, the

electrodes 7 and 8 are formed as pointed pins that penetrate through the bottom of the cartridge 12, extending into the propellant charge 13. Upon application of voltage to the electrodes 7 and 8, a spark, which is formed therebetween, ignites the powder propellant charge. In Ehmig'476, both the electrodes and the propellant charge are located in one and the same space in contact with each other.

Suckewer discloses a completely different ignition system for use in a different type of an apparatus, namely, a spark ignition system for an internal combustion engine. In the ignition system of Suckewer, an internal, pin-shaped electrode 18 extends through an insulator 22 on which an external electrode 20 is supported. Both the internal electrode 18 and the external electrode 20 project beyond the insulator 22 and, as shown in Fig. 5, extend into the combustion space of the cylinder 92, in the midst of the gaseous air/fuel mixture (column 3, lines 36-38). Contrary to the assertion made in the office action, Suckewer does not disclose a channel formed in an insulator and through which the tip of a pin-shaped electrode communicates with the environment. In Suckewer, the tip of the pin-shaped electrode (18) (the end surface) communicates directly with the environment. The annular space between the pin-shaped electrode (18) and the

annular electrode (20) does not form a channel in which an electrical arc extends when voltage is applied to the two electrodes.

Generally, Suckewer is not believed to be a particular relevant reference. It is doubtful that one involved in design of ignition devices or systems for igniting foil cartridges filled with a solid propellant charge for hand-held, explosion-operated tools would look for solution of his/her problem to the field of internal combustion engines. Even assuming, *arguendo*, that Ehmig and Suckewer could be combined, the combination of Ehmig and Suckewer would not disclose a displaceable support and an annular electrode displaceable therewith between two positions.

The spacing between the annular electrode and the power foil insures unobstructed transportation of the cartridge belt in the power tool.

Under MPEP § 21433 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first and third elements of *prima facie* obviousness have not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teaching of references can be combined only if there is some suggesting or incentive to do so”.

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (footnote omitted)

(emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6(Fed. Cir. 1983):

SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468,

1475 (Fed. Cir. 1988); In re Laskowski, 10 U.S.P.Q. 2d 1397, 1399 (Fed. Cir.

1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter.

1993). In order to establish a prima facie case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* at 1301 (emphasis in original). No such evidence is seen in the Office Action.

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record in *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q. 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 USPQ 972,973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is present in the Office Action.

In view of the above, it is respectfully submitted that Claim 1 is patentably defines over the combination of Ehmig and Suckewer and is, therefore, allowable.

The secondary references likewise do not disclose or suggest the novel features of the present invention.

Claims 2-9 depend on claim 1 and are allowable for the same reason claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 1, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal

respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Alexander Zinchuk

Reg. No. 30,541

Dated: February 7, 2005

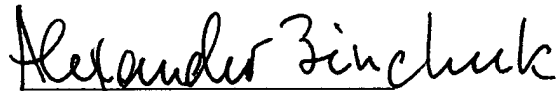
Sidley Austin Brown & Wood LLP

787 Seventh Avenue

New York, N.Y. 10019

Tel.: (212) 839-7355

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail and addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 7, 2005.



Alexander Zinchuk